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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,836	05/24/2001	Hideyuki Ishikawa	SHC0127	4999

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EXAMINER

REICHLER, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 07/14/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/864,836

Applicant(s)

ISHIKAWA, HIDEYUKI

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2002 and 20 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 October 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### **DETAILED ACTION**

1. It is noted that the response filed 1-20-03 still did not comply with 37 CFR 1.121 in that the marked up copies did not show all the changes made to the 5-24-01 version of claim 1 to arrive at the 1-20-03 version. The Examiner has done so in red ink to the various marked up copies.

#### ***Specification***

#### ***Drawings***

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 10-17-02 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

#### ***Description***

3. The substitute specification filed 10-17-02 has not been entered because it does not conform to 37 CFR 1.125(b) because: contrary to Applicant's 1-20-3 remarks, 1.125(b)(2)

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requires a marked up copy of the substitute specification showing the matter being added to and the matter being deleted from the specification of record(emphasis added), which in this case is the specification as amended 5-24-01, not the original specification as supplied by Applicant.

4. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: page 5, lines 5-12.

5. The amendment filed 5-24-01 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the second paragraph on page 3, i.e. where is there support for there being more than one process of making the invention?

Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Objections*

6. Claims 1-7 are objected to because of the following informalities: in claim 1, lines 4, 16 and 20, "contacting" should be --contactable--. On line 8, "transversal" should be --transverse--.

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On line 19, "in" should be --on--. In claim 7, line 15, "stretched and contracted composite sheet as a" should be deleted. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now requires that the covering be more easily stretchable in a direction of, i.e. towards, the skin contacting surface in the first zone than in the remainder thereof. The original specification, e.g. Figures 2-3, shows a cover which is more easily stretchable away from the skin contacting surface.

***Claim Rejections - 35 USC § 102/103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-3, and 7 are rejected under 35 U.S.C. 102(b) as anticipated by Divo et al, EP '714, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Divo et al, EP '714, in view of Serbiak et al, '232, and Morman et al, '760.

Claims 1-3: See Figures 1-4, 6, 9-13, col. 6, lines 31-39, col. 1, lines 3-16, col. 3, lines 52-55, col. 8, line 6-col. 9, line 6 (Note definition of "nonwoven" in Materials Handbook provided in the last Office Action), col. 9, line 19-col. 10, line 19, col. 12, line 20-col. 13, line 5, col. 14, lines 28-30, col. 15, line 42 -col. 16, line 4, i.e. the cover is 26, the pervious sheet is 24, the core is 28, the elastic members are 32, the first layer is 5 or 11, the second layer is 3 or 7 and 15. Figures 2-3, paragraph bridging cols. 8-9 and col. 6, lines 31-39 disclose the ratio set forth on lines 10-15 of claim 1. It is the Examiner's first position that col. 6, lines 31-39 also teach the structure of lines 17-18 of claim 1 and claim 2. Lines 15-17 and 18 et seq of claim 1, as best understood, note new matter rejection supra, recite function or capability of the claimed structure. The Divo device includes the same structure, see cited portions above. Therefore there is sufficient factual basis to conclude that the function or capability of the claimed structure is also inherent in the same structure of Divo. See MPEP 2112.01. In any case, the Examiner's second position, Divo, at the very least, teaches providing elasticity to a backsheet consisting of the composite elastic member wherein only parts of the composite are activated or extensible while others are not. Serbiak et al and Morman et al teach, see Figures thereof, it is known in the diaper art to provide elasticity to a

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backsheet consisting of a composite elastic member wherein only the transverse middle zone part is extensible while the remainder is not. Such structure is for the purposes of better fit and comfort, see abstract of Morman and col. 12, lines 31-32 of Serbiak et al. It is also noted that Serbiak et al also teaches such can be combined with elastic members or not, see col. 12, line 26-28 thereof. Therefore to make the part of the composite which is activated or extensible only the transverse middle portion of the backsheet as taught by Serbiak et al and Morman et al on the Divo et al device would be obvious to one of ordinary skill in the art in view of the recognition that such would provide a backsheet where only a portion is activated while the remainder is not as desired by Divo et al. Furthermore, such a feature would provide good fit as well as comfort and good fit is desirable in any diaper because otherwise it does not contain fluid. Lines 15-17 and 18 et seq of claim 1, as best understood, note new matter rejection supra, recite function or capability of the claimed structure. The prior art combination teaches the same structure, see cited portions above. Therefore, there is clear and convincing evidence that the claim's functional or characteristic recitation necessarily flows and/or is inevitably present in the teachings of the prior art of record.

Claim 7: see discussion of claims 1-3 supra and the portions of Divo et al cited. The method of claim 7 is taught by Divo or, in the alternative, taught by the combination of Divo, Serbiak and Morman.

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***Claim Rejections - 35 USC § 103***

11. Claims 4 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Divo alone or Divo, Serbiak and Morman in view of Estey et al.

Applicant claims the elastic layer being formed of nonwoven material made of crimped fibers and the second layer made of polypropylene or propylene copolymers. Divo et al only discloses the elastic layer as being elastic films or nonwovens, see col. 8, lines 16-18 and col. 10, line 16 and the second layer being nonwovens of polyethylene, see col. 8, lines 13-15 and col. 10, lines 5-7, respectively. However, see Estey et al col. 1, lines 6-9, col. 6, lines 47-49, col. 16, lines 24-26, col. 8, lines 36-46 and col. 9, lines 22-26, i.e in the diaper art, in elastic composites, the interchangeability of elastic films and nonwovens of noncrimped fibers with elastic nonwoven webs of crimped fibers and the interchangeability of polyethylene nonwoven nonelastic for polypropylene or propylene copolymer nonelastic nonwovens. To make the elastic film or nonwoven of noncrimped fibers of Divo et al a nonwoven material made of crimped fibers instead and to make the second layer of Divo et al as claimed instead would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by Estey et al.

12. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Divo, Serbiak and Morman.

Applicant claims the elastic layer being formed of a liquid impervious sheet which lies inside the second layer. Divo et al only discloses such elastic layer as being elastic films or



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nonwovens and coextensive with the second layer initially and the desire that the backsheet be liquid impervious and have a clothlike appearance, see cited portions supra. However, see Serbiak et al at Figure 2, col. 6, lines 44 et seq, col. 7, lines 18-20 and col. 2, lines 42-47, i.e in the diaper art, in elastic composites, the interchangeability of elastic pervious films and elastic impervious films. To make the elastic film of Divo et al a fluid impervious elastic film instead would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by Serbiak et al. It would also provide the imperviousness of the backsheet as desired by Divo et al.

Additionally to make the elastic layer the innermost of the two layers as taught by Serbiak et al on the Divo et al device would be obvious to one of ordinary skill in the art as providing a more clothlike appearance as desired by Divo et al. The last two lines of claim 6 recite function or capability of the claimed structure. The prior art combination teaches the same structure, see cited portions above. Therefore, there is clear and convincing evidence that the claim's functional or characteristic recitation necessarily flows and/or is inevitably present in the teachings of the prior art of record.

***Response to Arguments***

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13. Applicant's remarks in the 1-20-03 and 10-17-02 response have been considered but are either deemed moot in that such remarks are directed to issues which have not been reraised or are deemed nonpersuasive for the reasons set forth supra.

*Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other prior art references cited shown various elastic composites.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any new grounds of rejection were necessitated by the amendments to the claims 1-7 and addition of claims 8-9.

16. Any inquiry concerning this communication should be directed to K. M. Reichle at telephone number 703-308-2617. The Examiner's regular work schedule is Monday-Thursday. The Official RightFAX number is 703-872-9302.

KMR

July 8, 2003

*K.M. Reichle*  
~~KATHY REICHEL~~  
~~KATHY REICHEL~~